

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/038,158	WALLMAN, STEVEN M. H.	
	Examiner Alain L. Bashore	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to 4-5-04.
2.  The allowed claim(s) is/are 50-86.
3.  The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some\*    c)  None    of the:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6.  CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a)  including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1)  hereto or 2)  to Paper No./Mail Date \_\_\_\_\_.
  - (b)  including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

#### Attachment(s)

1.  Notice of References Cited (PTO-892)
2.  Notice of Draftsperson's Patent Drawing Review (PTO-948)
3.  Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 4-5-04
4.  Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5.  Notice of Informal Patent Application (PTO-152)
6.  Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7.  Examiner's Amendment/Comment
8.  Examiner's Statement of Reasons for Allowance
9.  Other \_\_\_\_\_.



Alain L. Bashore

## **DETAILED ACTION**

### **Resumption of Prosecution**

1. The suspension indicated in the previous office action has hereby expired. This action is in response to applicant's amendment filed 4-5-04. Claims 1-49 have been cancelled, claim 50 is amended, and defendant claims 51-86 newly added.

### **Declaration under 37 CFR 1.132**

2. The declaration under 37 CFR 1.132 received and made of record is sufficient in its totality to overcome a possible rejection of claim 50 based upon the Alaska Air Group Announcement reference. Especially convincing is paragraph four of applicant's declaration regarding motivation.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 50 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent No. 6,601,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

the recitation "investor preferences" could be broadly defined to one with ordinary skill in the art as to include "trading data", "user identification" or "preference information";

the recitation "investor" could be broadly defined to one with ordinary skill in the art as to include "user";

the recitation "employing the plurality of investor preferences to select a plurality of distinct market tradable assets or liabilities" could be broadly defined to one with ordinary skill in the art as to include "specifying from the trading data a user customizable portfolio"; and,

the recitation "placing one or more trades" could be broadly defined to one with ordinary skill in the art as to include "executing one or more trades".

#### ***Terminal Disclaimer***

5. The terminal disclaimer filed on 4-5-04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,601,044 has been reviewed and is accepted. The terminal disclaimer has been recorded. The double patenting rejection herein above is therefore obviated.

**EXAMINER'S AMENDMENT**

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In claim 50, line 1, before "method" insert --computer implemented--.

7. Authorization for this examiner's amendment was given in a telephone interview with Mr. Meier on 8-10-04.

***Allowable Subject Matter***

8. Claims 50-86 are allowed.

9. The following is an examiner's statement of reasons for allowance:

The present invention includes independent claim 50 reciting a computer implemented method.

The Alaska Air Group Announcement reference (announcement reference) is considered the closest prior art. The announcement reference teaches an offer to shareholders to act as agent to put together odd lots to be sold on the market in round lots.

The announcement reference does not disclose:

determining, based on an order to trade, a plurality of distinct marketable tradable assets or liabilities to be transacted in a market for each of the distinct assets or liabilities in a plurality of transactions for the user;

aggregating a plurality of transactions fore the user with a plurality of transactions for one or more other users over an applicable characteristic of the plurality of assets or liabilities, wherein the aggregating includes aggregating single shares, odd lots and/or fractional shares using a computer;

executing one or more trades based on the aggregating to implement the order to trade the specified customizable portfolio;

wherein the specified user customizable portfolio is owned directly by the user after said one or more trades.

As argued by Applicant as a distinction over the prior art, the allowed claims do not include any instance where purchases are only available from an issuer and can only be redeemed by the issuer.

The market tradable assets or liabilities as claimed is understood to include only those assets or liabilities that encompass shares tradable in a market.

The term portfolio is understood to mean a combined holding resulting from placing at least one trade creating an asset held by an investor. The combined holding includes at least one or more than one of: stock, bond, commodity, real estate investment, cash equivalent, or other asset owned by an investor.

For these reasons claim 50 is deemed to be allowable over the prior art of record, and claims 50-86 are allowable by dependency.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Drawings***

10. The application having been allowed, formal drawings are required in response to this Office Action. A notice of draftspersons review is attached to this action.

### ***Prior Art***

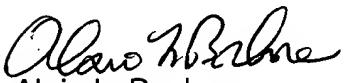
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The anonymous journal articles are cited to show aggregating; the One Share Of Stock Inc. reference is cited to show single share purchasing; and the dictionary reference is cited to show portfolio definition.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore